

## REMARKS

The Examiner rejected all claims based upon U.S. Patent No. 6,385,306 to Baxter, Jr. and U.S. Patent No. 6,507,643 to Groner. The effective dates of these references are their filing dates, which are March 2, 2000 and March 16, 2000, respectively.

Applicant asserted in the response to the Office Action mailed September 9, 2004 that Applicant invented the subject matter of the instant invention prior to the effective date of either Groner or Baxter, Jr. as evidenced by the affidavit under 37 C.F.R. §1.131 enclosed therein as Exhibit A. Part of Exhibit A was a document prepared by the Applicant prior to 2000 that evidenced the conception of the claimed invention. The Examiner disputed Applicant's reduction to practice prior to the effective dates of Groner and Baxter, Jr. and rejected the application in final.

Applicant encloses herewith as **Exhibit B** another affidavit under 37 C.F.R. §131 that includes significant evidence showing Applicant's prior conception followed by diligence from at least just before Groner's and Baxter, Jr.'s effective dates until the constructive reduction to practice when the instant application was filed in the U.S. Patent and Trademark Office. Therefore, the Groner and Baxter, Jr. references can no longer support a rejection under 35 U.S.C. §§102(e) or 103.

The evidence now before the Examiner shows that Applicant conceived of the invention prior to the effective date of the cited references. Furthermore, from at least just before the effective dates of the references (by mid-February, 2000) until the filing date of the instant application, (January 2002), Applicant was working diligently to reduce the invention to practice. Reduction to practice occurred no later than the filing date of January 4, 2002, making the period of diligence about 22 months (i.e., from before March 2, 2000 until January 4, 2002).

Applicant has shown continuous and reasonable diligence during the critical period. First, the invention is a type that cannot be tested without significant expense, and therefore Applicant consulted several consultants in the technology to determine whether it would work. He met with at least six such consultants over the course of almost two years, beginning with activity in mid-February 2000 that is confirmed by a signed confidentiality agreement dated three days after the earliest reference's effective date. Applicant discussed with these technical consultants the software development, user interface for the invention and details of the DTMF system necessary for the invention. Applicant also did his own analysis of the invention, including searching for similar inventions, and attempted to find investors who would aid him in research and development. Applicant retained a patent attorney for the purpose of performing a thorough patentability search, and then for obtaining a patent for the invention. Applicant purchased domain names for marketing the invention. All of this took place while he was working on many other inventions, changing jobs and starting a business, moving between cities and going through an engagement breakup.

Applicant's steady progress toward filing a patent application was restricted by the type of invention at issue. The invention incorporates telephony, email and other sophisticated technology. Such technology is prohibitively expensive to experiment with. Therefore, Applicant had to consult with others regarding the details of the technology itself, and regarding whether and how the technology could be used by consumers. Applicant did so while working full time or starting his own business, and was obviously limited by the schedules of those with which he was consulting. Nonetheless, evidence has been submitted proving that he was attending meetings with others and engaging in other activity related to reducing the invention to practice virtually every month during

the entire 22 month period. Those short periods in which there is no activity are explained by family difficulties, a move to another city and changes in employment.

The law does not require an inventor to work every moment in order to be diligent. *Mycogen Plant Science, Inc. v. Monsanto Co.*, 252 F.3d 1306 (Fed. Cir. 2001). Applicant has accounted for the entire period from just prior to the effective dates of the references until the filing of the application by demonstrating that he was diligently working to reduce the invention to practice during this period.

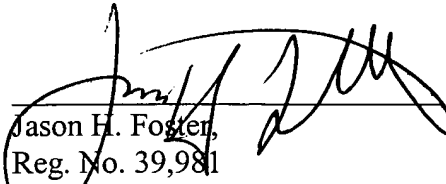
Therefore, the prior art references cited by the Examiner can no longer support a rejection under 35 U.S.C. §§102(e) or 103, because the references can no longer be considered prior art.

Reconsideration and allowance are respectfully requested. The Examiner is authorized to communicate with the undersigned attorney by email by the following recommended authorization language: Recognizing that Internet communications are not secure, I hereby authorize the USPTO to communicate with me concerning any subject matter of this application by electronic mail. I understand that a copy of these communications will be made of record in the application file. (authorization pursuant to MPEP 502.03)

The Commissioner is authorized to charge Deposit Account No. 13-3393 for any insufficient fees under 37 CFR §§ 1.16 or 1.17, or credit any overpayment of fees.

Respectfully submitted,

18 Oct. 2005  
Date of Signature

  
Jason H. Foster,  
Reg. No. 39,981

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Enclosure: Transmittal form  
Petition for Extension of Time  
Request for Continued Examination Transmittal  
Check in the amount of \$620.00  
Appendix including Declaration  
Return receipt postcard